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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,727	09/30/2003	Alan Verkman	UCSF-291	2946
500 75	90 10/19/2005		ЕХАМ	INER
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC			SPIVACK, PHYLLIS G	
701 FIFTH AVI SUITE 6300	E		ART UNIT	PAPER NUMBER
	SEATTLE, WA 98104-7092			
			DATE MAILED: 10/19/200	5

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
	10/676,727	VERKMAN ET AL.			
Office Action Summary	Examiner -	Art Unit			
	Phyllis G. Spivack	1614			
The MAILING DATE of this communication ap Period for Reply	pears on the cover sheet with	the correspondence address			
A SHORTENED STATUTORY PERIOD FOR REPL WHICHEVER IS LONGER, FROM THE MAILING E - Extensions of time may be available under the provisions of 37 CFR 1. after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period - Failure to reply within the set or extended period for reply will, by statut Any reply received by the Office later than three months after the mailine earned patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNICA 136(a). In no event, however, may a repl will apply and will expire SIX (6) MONTH te, cause the application to become ABAN	ATION. y be timely filed S from the mailing date of this communication. IDONED (35 U.S.C. § 133).			
Status					
1)⊠ Responsive to communication(s) filed on 11 A	August 2005.				
<u> </u>					
·—	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is				
closed in accordance with the practice under					
Disposition of Claims					
4) Claim(s) 1-64 is/are pending in the application	n				
4a) Of the above claim(s) is/are withdra	awn from consideration.				
5) Claim(s) is/are allowed.					
6) Claim(s) is/are rejected.					
7) Claim(s) is/are objected to.					
8) Claim(s) 1-64 are subject to restriction and/or	election requirement.				
Application Papers	·				
9) The specification is objected to by the Examin	er.				
10) The drawing(s) filed on is/are: a) ac	cepted or b) objected to by	the Examiner.			
Applicant may not request that any objection to the					
Replacement drawing sheet(s) including the correct	ction is required if the drawing(s)	is objected to. See 37 CFR 1.121(d).			
11) The oath or declaration is objected to by the E	xaminer. Note the attached C	Office Action or form PTO-152.			
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:	•	19(a)-(d) or (f).			
	1. Certified copies of the priority documents have been received.				
2. Certified copies of the priority document					
3. Copies of the certified copies of the price	•	eceived in this National Stage			
application from the International Bures					
* See the attached detailed Office action for a lis	t of the certified copies flot re	odivou.			
Attachment(c)					
Attachment(s) 1) Notice of References Cited (PTO-892)	4) Then iou Sur	nmary (PTO-413)			
2) Notice of References Cited (P10-692) Notice of Draftsperson's Patent Drawing Review (PT0-948)	Paper No(s)/I	Paper No(s)/Mail Date			
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08	5) Notice of Info 6) Other:	rmal Patent Application (PTO-152)			
Paper No(s)/Mail Date	0, L. Outer	•			

U.S. Patent and Trademark Office PTOL-326 (Rev. 7-05)

Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19 and 41-60, drawn to methods of treating a cystic fibrosis transmembrane conductance regulator (CFTR) protein-mediated condition or symptom, of inhibiting the activity of cystic fibrosis transmembrane conductance regulator protein, treating a condition associated with aberrant ion transport by cystic fibrosis transmembrane conductance regulator (CFTR) and pharmaceutical compositions of instant formula I, classified in class 514, subclass 369.
- II. Claim 20-39, drawn to methods for inhibiting the activity of cystic fibrosis transmembrane conductance regulator protein in a cell and in a cell in an *in vivo* assay, classified in class 435, subclass 7.2+.
- III. Claim 40, drawn to methods for producing the cystic fibrosis (CF) phenotype in a non-human animal, classified in class 800, subclass 3.
- IV. Claims 61-64, drawn to a non-human animal having a cystic fibrosis transmembrane conductance regulator (CFTR) deficiency, classified in class 800, subclass 14+.

The inventions are distinct, each from the other, for the following reasons:

The Groups have acquired a separate status in the art by their recognized, divergent subject matter and their different classification. The searches required for each Group are not co-extensive resulting in an undue burden to the Examiner. Each Group is capable of supporting a separate patent.

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Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § (37 CFR 1.143). 808.01). In the instant case the different inventions are drawn to methods of use of distinct effects.

Restriction for examination purposes as indicated is proper.

Should Applicants traverse on the ground that the species are not patentably distinct, Applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicants' Response to the Election Requirement filed August 11, 2005 is acknowledged. The elected species is (3-[(trifluoromethyl)phenyl]-5-[(4-carboxyphenyl)methylene]-2-thioxo-4-thiazolidinone).

Applicants are advised that to be complete, the reply to this requirement must include an election of the invention to be examined even though the requirement is traversed.

A telephone call to the attorney is not required where: 1) the restriction requirement is complex; 2) the application is being prosecuted *pro se*; or, 3) the Examiner knows from past experience that a telephone election will not be made. See MPEP 812.01.

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Where the Examiner has required restriction between product and process claims and Applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after Final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the Examiner before the patent issues withdraws the restriction requirement. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Phyllis G. Spivack whose telephone number is 571-272-0585. The examiner can normally be reached on 10:30 AM-7 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher Low can be reached on 591-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 17, 2005

Phyllis G. Spivack PHYLLIS: